

REMARKS

The Office Action mailed January 27, 2009, has been received and reviewed. Claims 1-25 are currently pending in the application. Claim 23 was allowed. Claims 1-22, 24 and 25 stand rejected. Applicant has amended claims 1, 3, 8, 9, 14, 15 and 19-25 and respectfully requests reconsideration of the application as amended herein. Support for Applicant's amendments is found at least paragraphs [1035-38] of Applicant's as-filed specification. No new matter has been added.

35 U.S.C. § 112 First Paragraph, Written Description Rejection

Claim 25 stands rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The Office Action states:

The claim is directed to a computer readable media: however the examiner was not able to find support for this limitation in the specification. Please remember that the specification have to specify a computer readable media, a mention of an abstract software program will not suffice. (Office Action, pp. 3-4).

Furthermore, the Office Action in the Response to Arguments states:

Applicant may *amend the claim to "a storage medium"* instead of "a computer readable media" *in order to overcome 112 1st issue and 101 issue* because paragraph 1046 clearly define storage medium is a memory, such as RAM or ROM, etc. (Office Action, p. 2; emphasis added).

Applicant has amended independent claim 25 to recite, *inter alia*, "A storage medium" as recommended by the Examiner. Accordingly, Applicant respectfully submits that claim 25 complies with the written description requirement of 35 U.S.C. § 112, first paragraph, and requests that the 35 U.S.C. § 112, first paragraph, rejection of this claim be withdrawn.

35 U.S.C. § 103(a) Obviousness Rejections

Obviousness Rejection Based on NPL XP-001017264, EP 0658014 and U.S. Patent No. 6,735,446

Claims 1-4, 6-10, 12-16, 18-20, 24 and 25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over NPL XP-001017264 to Siwko ("Siwko") in view of European Patent Applicant No. EP 0658014 to Redden *et al.* ("Redden") and further in view of U.S. Patent No. 6,735,446 to Iwata *et al.* ("Iwata").

To establish a *prima facie* case of obviousness *the prior art reference (or references when combined) must teach or suggest all the claim limitations*. *In re Royka*, 490 F.2d 981, 985 (CCPA 1974); *see also* MPEP § 2143.03. Additionally, there must be "a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements" in the manner claimed. *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1742, 167 L.Ed.2d 705, 75 USLW 4289, 82 U.S.P.Q.2d 1385 (2007). Finally, to establish a *prima facie* case of obviousness there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). Furthermore, the reason that would have prompted the combination and the reasonable expectation of success must be found in the prior art, common knowledge, or the nature of the problem itself, and not based on the Applicants' disclosure. *DyStar Textilfarben GmbH & Co. Deutschland KG v. C. H. Patrick Co.*, 464 F.3d 1356, 1367 (Fed. Cir. 2006); MPEP § 2144. Underlying the obvious determination is the fact that statutorily prohibited hindsight cannot be used. *KSR*, 127 S.Ct. at 1742; *DyStar*, 464 F.3d at 1367.

The 35 U.S.C. § 103(a) obviousness rejections of claims 1-4, 6-10, 12-16, 18-20, 24 and 25 are improper because the elements for a *prima facie* case of obviousness are not met. Specifically, the rejection fails to meet the criterion that the prior art reference must teach or suggest all the claims limitations.

Regarding independent claim 1 and claims 2-4, 6 and 7 depending therefrom, independent claim 8 and claims 9, 10, 12 and 13 depending therefrom, independent claim 14 and claims 15, 16 and 18 depending therefrom, independent claim 19 and claim 20 depending therefrom and independent claims 24 and 25, Applicant's independent claims 1, 8, 14, 19, 24 and 25 include claim limitations not taught or suggested in the cited references.

Generally, Applicant's invention as presently claimed recites (1) "receiving" and

“adjusting” “an initial call request block probability” at the “mobile station/apparatus” and (2) “blocking” as claimed by Applicant, wherein **“the mobile station blocks a call request by foregoing origination of the call request.”** Specifically, Applicant’s independent claims 1, 8, 14, 19, 24 and 25 each recite, *inter alia*, “receiving at a mobile station/an apparatus an initial call request block probability ...and adjusting at the mobile station/the apparatus said initial call request block probability based on said elapsed time, said adjusted call request block probability identifying when **the mobile station blocks a call request by foregoing origination of the call request.**” In contrast, neither Siwko nor Redden nor Iwata teach or suggest (1) giving *adjustment* control to a mobile station or (2) “blocking” as claimed by Applicant, wherein **“the mobile station blocks a call request by foregoing origination of the call request.”**

Regarding Siwko, Siwko generally teaches of mobile stations freely generating unrestrained call requests and then the network access controller chooses which ones to admit or reject. Specifically, the Office Action states:

Siwko discloses that the receiving and adjusting occur at network element [note that *network element can be any element connected to the network, including the mobile device*] (Office Action, p. 5; emphasis added).

The Office Action in the Response to Arguments section states:

In pages 10-12 applicant asserts that is clear in *Siwko* which elements are performing which task, however *only mention that is done by the network and fails to disclose exactly which part of the network is doing the CAC policy, which is basically the same conclusion of the examiner*. It seems that *the disagreement begins when the examiner interprets that the mobile station is part of the network*, which by definition since the mobile station are interconnected with the network they are part of the network. Thereby, *the examiner maintains its position that it is unclear which element does the CAC policy and the arguments were not persuasive since the applicant was not able to specifically point out which element of the network was doing the policy*. (Office Action, p. 2; emphasis added).

Applicant respects the Examiner’s position but provides the following quotations from Siwko to support the position that (1) Siwko does not teach or suggest giving *adjustment* control to a mobile station and (2) Siwko does not teach call blocking as “the mobile station blocks a call request by foregoing origination of the call request” as claimed by Applicant.

Regarding support that Siwko teaches mobile stations as not being part of Siwko’s

network, Siwko specifically discloses:

The *network resources* available to serve other, lower priority *users* will decrease
(Siwko, p. 351, right col., lines 6-7; emphasis added).

CAC policies protect a network from overloading by determining whether incoming connection requests should be accepted or rejected. (Siwko, p. 351, right col., lines 6-17; emphasis added).

Consider a multiple access *network whose* communication resources are shared among a multitude of *stations*. (Siwko, p. 352, left col., lines 26-27; emphasis added).

The network is connection oriented, so *stations desiring to use the network must* first submit a connection request to the network access controller. (Siwko, p. 352, left col., lines 27-30; emphasis added).

Clearly, Siwko's teachings above unquestionably support a "network" apart from "users" and "stations" since the "users" and "stations" receive access to "network resources."

Furthermore, their "connection requests" for "desiring to use the network" are "submit[ted]" to the "network" which "determin[es] whether incoming connection requests should be accepted or rejected." Additionally, since the "CAC policies protect a network ... by determining whether incoming connection requests should be accepted or rejected," the CAC policy forms part of the network and not the "stations." Accordingly, Siwko does not teach the stations are part of the "network", neither does Siwko teach the CAC policies are part of the "stations."

Regarding support that Siwko does not teach call blocking by foregoing origination of the call request, Siwko specifically discloses:

Connection requests arrive at the system according to a Poisson process with mean arrival rate λ . A *CAC policy decides whether a connection request is to be admitted or rejected*. Connections whose requests are rejected by the CAC policy are said to be blocked and are lost. A CAC policy must block a connection request if the connection's admission would cause the allocated resources to exceed the capacity. (Siwko, p. 352, left col., line 53-right col., line 3; emphasis added).

Clearly, Siwko's teachings above unquestionably teach call requests that are originated by a station and are then "blocked" by the network by being "rejected" after being received and subjected to the CAC policy. In contrast, Applicant's amended independent claims 1, 8, 14, 19, 24 and 25 each recite, *inter alia*, "the mobile station blocks a call request by foregoing origination of the call request" which is clearly not taught in Siwko. Applicant's claimed invention of "foregoing origination of the call request" prevents generation of unnecessary

interference and consumption of bandwidth while unnecessarily consuming power at the mobile station.

Therefore, according to Siwko, (1) all of the “receiving” and “adjusting” occur at the network and **not** at the “the mobile station/the apparatus” as claimed by Applicant, and (2) Siwko does not teach call blocking as “the mobile station blocks a call request by foregoing origination of the call request” as claimed by Applicant. Accordingly, the rejection is improper and must be withdrawn since the Office Action has improperly characterized the teachings of Siwko.

Regarding Redden, the Office Action states:

Redden discloses *receiving at a mobile station and an initial call request block probability* (Office Action, p. 5; emphasis added).

Furthermore, Redden teaches:

FIG. 9 illustrates procedure 300 *performed by* a communication node (for example, *satellite* 12 of FIG. 1) ..., the communication node [e.g., satellite] receives a parameter set from the communication system ... task 304 [performed in the satellite] modifies the parameter set ... [t]ask 314 [satellite] broadcasts the parameter set on at least one of the broadcast channels (Redden, p. 14, lines 4-19; emphasis added).

According to Redden, all of the “receiving” happens at either the satellite or at the mobile stations **after** the modifications have occurred while **all** of the “adjusting” happens either in the “communication node (e.g., satellite)” or the “communication system”. Accordingly, Redden also fails to teach of any “adjusting” occurring in the “the mobile station/the apparatus” as claimed by Applicant.

Regarding Iwata, the Office Action introduces Iwata and states:

Iwata discloses a mobile device that receives a broadcast message that permits or inhibits the mobile device to transmit and adjust accordingly (see col. 13, line 49-col. 14, line 40). Therefore, it would have been *obvious* to one of the ordinary skills in the art at the time of the invention *to combine these teachings* to let the mobile station know when it is possible to transmit and make a call, without the need of the mobile station transmit when the wireless resources are not present, thereby efficiently managing the finite wireless resources. (Office Action, pp. 5-6; emphasis added).

Applicant respectfully disagrees. Applicant respectfully reminds the Examiner that if a “proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.” M.P.E.P. §2143.01 (citing *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984)).

Applicant respectfully points out that Siwko is intended to have a “station” (e.g., mobile device) making a request to the network and *the network administering the CAC policies by accepting or rejecting the request*. The proposed modifications from Iwata of a broadcast message sent to a mobile device that “permits or inhibits the mobile device to transmit and adjust accordingly” (Office Action, p. 5) would destroy the intended purpose of Siwko in having the network receive requests from mobile stations and then having the *network administer the CAC policies* by admitting or rejecting the request based upon the network’s knowledge of the available connection resources. (Siwko, p. 352, left col., line 53-right col., line 1). Therefore, *the Office Action’s proposed modification of Siwko by Iwata results in Siwko being destroyed for its intended purpose* of decision intelligence being retained at the network and mobile stations being controlled by the network. Therefore, there can be no motivation for such a proposed combination. Furthermore, there could be no motivation to provide CAC policy in a mobile station when CAC policy already exists at the network level as taught by Siwko. Accordingly, the rejection is improper and must be withdrawn.

Therefore, since Siwko, Redden and Iwata, either individually or in any proper combination do not teach or suggest all of Applicant’s claim elements and furthermore since there can be no motivation to combine these references when the reference’s intended purpose is destroyed, these references **cannot** render obvious, under 35 U.S.C. §103, Applicant’s invention as presently claimed in Applicant’s independent claims 1, 8, 14, 19, 24 and 25 which each recite, *inter alia*, “receiving at a mobile station/an apparatus an initial call request block probability ...and adjusting at the mobile station/the apparatus said initial call request block probability based on said elapsed time, said adjusted call request block probability identifying when the mobile station blocks a call request by foregoing origination of the call request.” Accordingly, Applicant respectfully requests the rejection of independent claims 1, 8, 14, 19, 24 and 25 be withdrawn.

The nonobviousness of independent claims 1, 8, 14 and 19 preclude rejection of claims 2-

4, 6, 7, 9, 10, 12, 13, 15, 16, 18 and 20 which variously depend therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. See In re Fine, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), see also MPEP § 2143.03. Therefore, Applicant requests that the Examiner withdraw the 35 U.S.C. § 103(a) obviousness rejection to independent claims 1, 8, 14 and 19 and claims 2-4, 6, 7, 9, 10, 12, 13, 15, 16, 18 and 20 which variously depend therefrom.

Obviousness Rejection Based on Siwko, Redden, Iwata and U.S. Patent No. 4,493,102

Claims 5, 11 and 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Siwko in view of Redden and Iwata and further in view of U.S. Patent No. 4,493,102 to Weishaupt ("Weishaupt").

The nonobviousness of independent claims 1, 8 and 14 preclude rejection of claims 5, 11 and 17 which respectively depend therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. See In re Fine, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), see also MPEP § 2143.03. Therefore, Applicant requests that the Examiner withdraw the 35 U.S.C. § 103(a) obviousness rejection to independent claims 1, 8 and 14 and claims 5, 11 and 17 which respectively depend therefrom.

Obviousness Rejection Based on Redden, Siwko and Iwata

Claims 21 and 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Redden in view of Siwko and further in view of Iwata.

To establish a *prima facie* case of obviousness ***the prior art reference (or references when combined) must teach or suggest all the claim limitations***. *In re Royka*, 490 F.2d 981, 985 (CCPA 1974); see also MPEP § 2143.03. Additionally, there must be "a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements" in the manner claimed. *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1742, 167 L.Ed.2d 705, 75 USLW 4289, 82 U.S.P.Q.2d 1385 (2007). Finally, to establish a *prima facie* case of obviousness there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). Furthermore, the reason that would have prompted the combination and the reasonable expectation of success must be found in the prior art, common

knowledge, or the nature of the problem itself, and not based on the Applicants' disclosure. *DyStar Textilfarben GmbH & Co. Deutschland KG v. C. H. Patrick Co.*, 464 F.3d 1356, 1367 (Fed. Cir. 2006); MPEP § 2144. Underlying the obvious determination is the fact that statutorily prohibited hindsight cannot be used. *KSR*, 127 S.Ct. at 1742; *DyStar*, 464 F.3d at 1367.

Furthermore, it "is improper to combine references where the references teach away from their combination." M.P.E.P. §2145(X)(D)(2) (citing *In re Grasselli*, 713 F.2d 731, 743, 218 U.S.P.Q. 769, 779 (Fed. Cir. 1983)). Similarly, *if a "proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification."* M.P.E.P. §2143.01 (citing *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984)).

The 35 U.S.C. § 103(a) obviousness rejections of claims 21 and 22 are improper because the elements for a *prima facie* case of obviousness are not met. Specifically, the rejection fails to meet the criterion that the prior art reference must teach or suggest all the claims limitations. Regarding independent claim 21 and claim 22 depending therefrom, Applicant's independent claim 21 includes claim limitations not taught or suggested in the cited references.

Generally, Applicant's invention recites (1) "determining" and "adjusting" "an initial call request block probability" **all at the same entity**, namely at the "apparatus" and (2) "blocking" as claimed by Applicant, wherein **"the mobile station blocks a call request by foregoing origination of the call request."** Specifically, Applicant's independent claim 21 recites, *inter alia*, "determining at the mobile station an elapsed time from an effective time of said initial call request block probability, wherein the block probability is determined by a network element and adjusting at the mobile station said initial call request block probability based on said elapsed time, **said adjusted call request block probability identifying when the mobile station blocks a call request by foregoing origination of the call request."**

Applicant herein sustains the above-proffered arguments that Redden, Siwko and Iwata, either individually or in any proper combination, do not teach or suggest all of Applicant's claim elements and therefore cannot render Applicant's claimed invention obvious under 35 U.S.C. § 103. Accordingly, the rejection of claim 21 must be withdrawn.

Additionally, Applicant respectfully reminds the Examiner that if a "proposed modification would render the prior art invention being modified unsatisfactory for its intended

purpose, then there is no suggestion or motivation to make the proposed modification.” M.P.E.P. §2143.01 (citing *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984)).

Again, Applicant respectfully points out that Siwko is intended to have a “station” (e.g., mobile device) making a request to the network and the network accepting or rejecting the request. The proposed modifications from Iwata of a broadcast message sent to a mobile device that “permits or inhibits the mobile device to transmit and adjust accordingly” (Office Action, pp. 8-9) would destroy the intended purpose of Siwko in having the network receive requests from mobile stations and then admit or reject based upon the network’s knowledge of the available connection resources. (Siwko, p. 352, left col., line 53-right col., line 1). Therefore, *the Office Action’s proposed modification of Siwko by Iwata results in Siwko being destroyed for its intended purpose* of decision intelligence being retained at the network and mobile stations being controlled by the network. Therefore, there can be no motivation for such a proposed combination. Accordingly, the rejection is improper and must be withdrawn.

Therefore, since Redden, Siwko and Iwata, either individually or in any proper combination do not teach or suggest all of Applicant’s claim elements and furthermore since there can be no motivation to combine these references when the reference’s intended purpose is destroyed, these references cannot render obvious, under 35 U.S.C. §103, Applicant’s invention as presently claimed in Applicant’s independent claim 21 which each recites, *inter alia*, “determining at the mobile station an elapsed time from an effective time of said initial call request block probability, wherein the block probability is determined by a network element and adjusting at the mobile station said initial call request block probability based on said elapsed time, said adjusted call request block probability identifying when *the mobile station blocks a call request by foregoing origination of the call request.*” Accordingly, Applicant respectfully requests the rejection of independent claim 21 be withdrawn.

The nonobviousness of independent claim 21 precludes rejection of claim 22 which depends therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. See *In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), *see also* MPEP § 2143.03. Therefore, Applicant requests that the Examiner withdraw the 35 U.S.C. § 103(a) obviousness rejection to independent claim 21 and claim 22 which depends therefrom.

Serial No. 09/853,322

Allowable Subject Matter

Claim 23 is allowable.

Applicant acknowledges this indication with appreciation

ENTRY OF AMENDMENTS

The proposed amendments to claims 1, 3, 8, 9, 14, 15 and 19-25 above should be entered by the Examiner because the amendments are supported by the as-filed specification and drawings and do not add any new matter to the application. Further, the amendments do not raise new issues or require a further search. Finally, if the Examiner determines that the amendments do not place the application in condition for allowance, entry is respectfully requested upon filing of a Notice of Appeal herein.

CONCLUSION

Claims 1-25 are believed to be in condition for allowance, and an early notice thereof is respectfully solicited. Should the Examiner determine that additional issues remain which might be resolved by a telephone conference, the Examiner is respectfully invited to contact Applicant's undersigned representative.

Respectfully submitted,

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